

REMARKS

Claims 1-32 are pending in this application. Claims 3-5, 10, 12, 15-20, 25, 27, and 30-32 have been amended, claims 33 and 34 have been added by the present Amendment. Amended claims 3-5, 10, 12, 15-20, 25, 27, and 30-32 and new claims 33 and 34 do not introduce any new subject matter.

REJECTIONS UNDER 35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131.

Reconsideration is respectfully requested of the rejection of claims 1-4, 6-12, 14-19, 21-27 and 29-32 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0123147 ("Everett").

Everett does not disclose wireless transmission of visual signals, as recited in claims 1, 17 and 32, and does not disclose a digital transmission means or a digital broadcast transmitter for wirelessly transmitting the visual signals and the audio signals, as recited in claims 17 and 32. Further, even if Everett did disclose these features, the provisional application from which Everett claims priority does not enable such features. Accordingly, the Examiner is not able to rely on the December 5, 2003 filing date of the provisional application to antedate the December 31, 2003 filing date of the instant application.

Everett Does Not Disclose The Limitations Of Claims 1, 17 and 32

Everett does not teach wireless transmission of visual signals

Applicant respectfully submits that Everett does not disclose or suggest wireless transmission of visual signals, as recited in claims 1, 17 and 32.

It is apparent throughout the specification that the device in Everett is configured to wirelessly transmit audio signals only and does not transmit visual signals. For example, paragraph 002 of Everett states that the “invention is directed to a wireless audio FM transmitter for a digital audio player”. Similarly, paragraph 011 states that the “FM transmitter 3 has been designed to receive audio signals”, and paragraph 0013 addresses “right and left channel audio signals”.

The Examiner apparently relies on claim 11 of Everett as teaching transmission of visual signals. Claim 11 reads “modulating the signal of said transmitter with the signal from said audio/video player”. Although the “signal” comes from an audio/video player, this does not lead to the conclusion that the signal is a visual signal. Indeed, such a conclusion is the result of hindsight gleaned from Applicant’s disclosure.

Based on the Everett specification, there is no indication that the signal is anything but an audio signal. The audio signal is simply being generated from a device that plays both audio and video. There is no teaching or support for the conclusion that a visual signal is being wirelessly transmitted.

Therefore, Applicant respectfully submits that Everett fails to teach or suggest wireless transmission of visual signals, as recited in claims 1, 17 and 32.

Applicant also notes that Everett fails to disclose a receiver that includes a display for displaying visual information derived from the visual signals transmitted by

the wireless transmitter, as recited in claims 12 and 27.

Everett does not teach a digital transmission means or a digital broadcast transmitter for wirelessly transmitting the visual signals and the audio signals

Applicant respectfully submits that Everett does not disclose a digital transmission means or a digital broadcast transmitter for wirelessly transmitting the visual signals and the audio signals, as recited in claims 17 and 32.

Everett's references are only to an FM transmitter. Indeed, the title of the invention is "FM transmitter for an MP3 player". Further, throughout the specification, the references to the transmitter in Everett are to "FM transmitter 3".

Accordingly, there is no teaching or suggestion of a digital transmission means or a digital broadcast transmitter, as recited in claims 17 and 32.

Applicant also notes that Everett fails to disclose the digital radio and the digital broadcast transmitter, as recited in claims 25 and 30, respectively.

Therefore, Applicant respectfully submits that independent claims 1, 17 and 32 are not anticipated by Everett. Claims 2-4, 6-12 and 14-16 depend from claim 1, and claims 18-19, 21-27 and 29-31 depend from claim 17, which, for the reasons stated hereinabove, are submitted not to be anticipated by the cited reference. For at least those very same reasons, claims 2-4, 6-12, 14-16, 18-19, 21-27 and 29-31 are also submitted not to be anticipated by the cited reference.

The Provisional Application From Which Everett Claims Priority Does Not Provide Adequate Support For The Rejections Based On Everett

Applicant respectfully submits that the Examiner is not able to rely on the December 5, 2003 filing date of provisional application no. 60/527,202 ("202 application") to antedate the December 31, 2003 filing date of the instant application.

M.P.E.P. § 2136.03 states that:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications . . . entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

M.P.E.P. § 2136.03 (Rev. 3, Aug. 2005) (emphasis added).

Further, 35 U.S.C. 112, first paragraph states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112.

Applicant respectfully submits that even if Everett disclosed wireless transmission of visual signals in the portions cited by the Examiner, the disclosure of the '202 application does not provide adequate support for such a disclosure.

The '202 application includes 3 pages of a specification, 3 claims, 5 pages of drawings and 35 pages of a "Test Record" for product verification. Nowhere in the '202 application is reference made to wireless transmission of visual signals. Indeed, the '202 application specifically states that the "invention relates to a wireless audio FM transmitter" and that there is a need for an apparatus that can receive and transmit audio signals. See, e.g., '202 application, specification at pages 1-2. Further, the Test Record repeatedly refers to a "wireless audio FM transmitter", and there is no mention of wireless transmission of visual signals. See, e.g., '202 application, Test Record at

pages 3-5 and 8-17.

As such, the disclosure of the '202 application does not enable wireless transmission of visual signals. Therefore, the Examiner is not entitled to rely on the December 5, 2003 filing date of the '202 application to antedate the December 31, 2003 filing date of the present invention.

As a result, Everett is not usable as a prior art reference against the instant application and the rejections based on Everett should be withdrawn.

Accordingly, based on the foregoing, the Examiner should withdraw the rejection of claims 1-4, 6-12, 14-19, 21-27 and 29-32 under 35 U.S.C. § 102(e) and claims 1-4, 6-12, 14-19, 21-27 and 29-32 are in condition for allowance.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 5 and 20

Reconsideration is respectfully requested of the rejection of claims 5 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Everett in view of U.S. Patent Application Pub. No. 2003/0226148 ("Ferguson").

Applicant respectfully submits that Everett, when taken alone or in combination with Ferguson, fails to teach or suggest wireless transmission of visual signals, as recited in claims 1 and 17, and the digital transmission means, as recited in amended claim 17.

As stated above, Everett does not disclose or suggest these features. Further, it would not be obvious to modify Everett to include the recited features.

Applicant notes that the addition of Ferguson does not render the claimed features obvious. Ferguson does not disclose wireless transmission of visual signals,

In Ferguson, video is transmitted via cables coupled to a monitor. Further, only audio signals are broadcast by the FM transmitter 14. See, e.g., Ferguson, ¶¶ 0029-0030.

Ferguson also does not disclose a digital transmission means for wirelessly transmitting the visual signals, as recited in claim 17. In contrast, Ferguson discloses an FM transmitter 14 for transmitting audio signals.

Therefore, Ferguson does not provide any disclosure or suggestion to develop the claimed embodiments.

Therefore, it is respectfully submitted that the cited references, when taken alone or in combination, do not disclose or suggest the embodiments of the present invention, as defined in claims 1 and 17, and that it would not have been obvious to modify Everett in view of Ferguson, to develop same.

As such, Applicant respectfully submits that the embodiments of the invention as defined in claims 1 and 17 are patentable over Everett in view of Ferguson. For at least the reason that claim 5 depends from claim 1, and claim 20 depends from claim 17, claims 5 and 20 are also submitted to be patentably distinct over the cited references.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 5 and 20 under 35 U.S.C. § 103(a) and that claims 5 and 20 are in condition for allowance.

Claims 13 and 28

Reconsideration is respectfully requested of the rejection of claims 13 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Everett in view of U.S. Patent Application Pub. No. 2004/0234081 ("Brice").

Applicant respectfully submits that Everett, when taken alone or in combination

with Brice, fails to teach or suggest wireless transmission of visual signals, as recited in claims 1 and 17. Further, Applicant respectfully submits that there is no motivation to combine Everett with Brice.

Brice Does Not Disclose Wireless Transmission Of Visual Signals

Brice does not disclose wireless transmission of visual signals. Accordingly, the addition of Brice does not render this feature obvious. In Brice, video is transmitted via a physical connection from a video player to a monitor. See, e.g., Fig. 1. Moreover, Brice is concerned with wireless transmission of multiple audio signals, and does not address wireless transmission of visual signals. See, e.g., Brice ¶ 0005.

There Is No Motivation To Combine Everett With Brice

Applicant maintains that there is no motivation to combine Everett with Brice to develop the claimed embodiments.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Everett is concerned with a compact and portable device for attaching to a single personal media player so that the media player can be used in a vehicle. The device in Everett can be moved from vehicle to vehicle along with the media player to which it attaches. In stark contrast, Brice relates to an elaborate system which is permanently installed in a vehicle, including a transmitter which is simultaneously attached to multiple audio/video sources. See, e.g., Brice, Fig. 1 and ¶ 0026 (stating that the transmitter in Brice “may be installed into, behind or underneath the dashboard or instrument panel . .

[or] incorporated with one or more audio source devices into a unified system”).

As a result, due to the differences between the devices of Everett and Brice, there is no suggestion to combine these two references to result in the claimed embodiments.

Therefore, Brice does not provide any disclosure or suggestion and there is no motivation to combine Everett with Brice to develop the claimed embodiments.

Thus, it is respectfully submitted that the cited references, when taken alone or in combination, do not disclose or suggest the embodiments of the present invention, as defined in claims 1 and 17, and that it would not have been obvious to modify Everett in view of Brice, to develop same.

As such, Applicant respectfully submits that the embodiments of the invention as defined in claims 1 and 17 are patentable over Everett in view of Brice. For at least the reason that claim 13 depends from claim 1, and claim 28 depends from claim 17, claims 13 and 28 are also submitted to be patentably distinct over the cited references.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 13 and 28 under 35 U.S.C. § 103(a) and that claims 13 and 28 are in condition for allowance.

NEW CLAIMS

Applicant respectfully submits new claims 33-34 for consideration. Applicant respectfully submits that new claims 33-34 are patentable over the cited references for at least the reasons (1) that claims 33-34 depend from independent claim 1, which Applicant submits is in condition for allowance; and (2) that the cited references do not disclose or suggest a receiver that is a digital radio and the digital broadcast transmitter,

as recited in claims 33 and 34, respectively.

An early and favorable reconsideration is earnestly solicited. If the Examiner has any further questions or comments, the Examiner may telephone Applicant's Attorney to reach a prompt disposition of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael F. Morano", is written over a horizontal line.

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